

**Notice of Allowability**

Application No.

10/817,527

Examiner

John Juba, Jr.

Applicant(s)

KRAHMER ET AL.

Art Unit

2872

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to August 11, 2005 submission and telephone interview of 9/28/2005.
2. ☒ The allowed claim(s) is/are 1-56 and 82.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |                                                                                                                     |                                                                                        |
|---------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)                                                    | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                    |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|                                                                                                                     | 9. <input type="checkbox"/> Other _____.                                               |

***Examiner's Amendment***

This application is in condition for allowance except for the presence of claims 65 – 81 and 83 drawn to inventions II and III non-elected without traverse. Accordingly, these claims have been cancelled.

**In the Claims:**

Claims 1 – 56 and 82 STAND as originally presented.

Claims 65 – 81 and 83 have been CANCELED.

Claim 18 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 9 – 15, 21, 22, 24 – 27, 37, 38, 40 – 42, 46, 47, and 49 - 51, directed to the species of the crystal optic axis orientations are no longer withdrawn from consideration since all of the claims to these species depend from or otherwise include each of the limitations of an allowed generic claim.

Similarly, claim 54 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 55, 56, 16, and 17, directed to the species of the crystal optic axis orientations are no longer withdrawn from consideration since all of the claims to these species depend from or otherwise include each of the limitations of an allowed generic claim.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance: The prior art, taken alone or in combination, fails to teach or fairly suggest

an objective wherein (111)-lenses are arranged with a rotation relative to each other about the lens axes in such a manner that a distribution  $\Delta\text{OPL}(\alpha_R, \theta_R)$  has significantly reduced values of  $\Delta\text{OPL}$  in comparison to an arrangement where said (111)-lenses are not arranged with said rotation relative to each other, as recited in claim 1;

a method of manufacturing objectives comprising at least two fluoride crystal (111)-lenses, including the steps of determining  $\Delta\text{OPL}(\alpha_R, \theta_R)$  and arranging the (111)-lenses in rotated positions relative to each other about the lens axes in such a manner that a remaining distribution function  $\Delta\text{OPL}(\alpha_R, \theta_R)$  is significantly reduced in magnitude compared to an arrangement where the (111)-lenses are not arranged in said rotated positions, as recited in claim 8;

an objective comprising at least two lenses consisting of fluoride crystal material, wherein said lenses have lens axes oriented substantially in a principal crystallographic direction, wherein the lenses are arranged with a rotation relative to each other about the lens axes in such a manner that a distribution  $\Delta\text{OPL}(\alpha_R, \theta_R)$  has significantly reduced values of  $\Delta\text{OPL}$  in comparison to an arrangement where said lenses are likewise oriented in said principal crystallographic direction, but are not arranged with said rotation relative to each other, as recited in claim 18, or as more specifically recited in claim 9 or 82;

a method of manufacturing objectives that comprise at least two fluoride crystal lenses, wherein said lenses have lens axes and each of said lens axes is oriented substantially in a principal crystallographic direction, the method comprising the steps of determining  $\Delta\text{OPL}(\alpha_R, \theta_R)$  and arranging the lenses in rotated positions relative to each other about the lens axes in such a manner that a remaining distribution function  $\Delta\text{OPL}(\alpha_R, \theta_R)$  is significantly reduced in magnitude compared to an arrangement where the lenses are likewise in said principal crystallographic direction, but wherein the lenses are not arranged in said rotated positions, as recited in claim 54, or as more specifically recited in claim 16 or 17.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Post-allowance papers should be mailed to **Box Issue Fee**. Post-allowance papers may also be faxed to **Box Issue Fee** via the new centralized facsimile number, which is (571) 273-8300. The **PUBs customer service** number is (571) 272-4200.

***Interview Summary***

On September 23, 2005, the examiner contacted Applicants' representative, Mr. Christopher Bowley (Reg. no. 55,016) to discuss the claim for priority under 35 U.S.C. §119 (a-d). Subsequently, it was determined that the instant application (filed April 1, 2004) was not copending with parent application PCT/EP02/05050 (filed May 8, 2002). Thus, although Applicants had submitted translated copies of the German priority documents, priority is only available by way of parent application serial numbers 10/367,989 and PCT/EP02/05050. The examiner determined that PCT/EP02/05050 had later published as WO 02/93209A3 on October 23, 2003, which fairly evidences copendency of parent application serial number 10/367,989 (filed February 12, 2003). However, the examiner did not find a reference in the specification or in an application data sheet of U.S. 10/367,989 to its parent, PCT/EP02/05050, as required under 35 U.S.C. §120. Applicants' representative pointed out that an amendment to the specification of U.S. 10/367,989 to include a reference to the parent had indeed been included with the transmittal on February 12, 2003, prior to the rule change under 37 CFR 1.121 (eff. 30 July 2003), which would have required a replacement paragraph. Thus, all of the requirements have been met such that the benefit of the earlier filed German applications can be accorded.

Having reviewed the priority documents, the examiner has determined that the aspect of correcting an optical objective with fluoride cubic crystalline lenses as to an optical path length difference as a function of azimuth angle and aperture angle by

relative rotation of a lens was disclosed by Applicants in May of 2001. Since the Hoffman, et al reference applied in the last Office action (U.S. Patent number 6,683,710) has an effective filing date only as early as June 2005, Applicants' benefit of the earlier filing under 35 U.S.C. §119(a-d) is sufficient to antedate the reference.

In light of Applicants' perfected claim for priority, the previous rejection of Claims 1, 8, 18, 20, 23, 24, 28, 32, 33, 35, 36, 39, and 54 under 35 U.S.C. §102(e) as being anticipated by Hoffman, et al (U.S. Patent number 6,683,710) is *withdrawn*, along with the rejection of claims 3, 7, 43, 44, 45, and 48 under 35 U.S.C. §103(a) as being unpatentable over Hoffman, et al (U.S. Patent number 6,683,710). For the same reason, the previous rejection of claims 52, 53, and 82 under §103(a) as being unpatentable over NIKON Corp (EP 1 138139 A1), in view of Hoffman, et al (U.S. Patent number 6,683,710) is *withdrawn*.

The last remaining issue was the provisional double-patenting rejection of claims 18, 19, 20, 28, 29, 30, 32, 33, 35, 52, and 53 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 9, 17, 10, 11, 12, 14, 15, 16, 47, and 48 of copending Application No. 10/931,745; and of claim 23 under this doctrine as being unpatentable over each of claims 41 - 46 of copending Application No. 10/931,745. On September 28, 2005, Mr. Christopher Bowley contacted the examiner to point out that Application No. 10/931,745 had not yet been examined, and that under MPEP 804, it is appropriate to withdraw the provisional double-patenting rejection, and allow the instant application to pass to issue. Accordingly, these rejections are *withdrawn*.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (571) 272-2314. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Drew Dunn whose number is (571) 272-2312 and who can be reached on Mon.- Thu., 9 - 5.

The **new centralized fax phone number** for the organization where this application or proceeding is assigned is (571) 273-8300 for *all* communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2800.

  
**JOHN JUBA, JR.**  
**PRIMARY EXAMINER**  
**Art Unit 2872**

September 28, 2005